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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/651,304	08/28/2003	Kazuhiko Kitamura	U 014788-6	9030
7590 03/23/2005			EXAMINER	
Ladas & Parry 26 West 61 Street New York, NY 10023			SHAH, MANISH S	
			ART UNIT	PAPER NUMBER
			2853	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/651,304

Applicant(s)

KITAMURA ET AL.

Examiner

Manish S. Shah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05/07/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

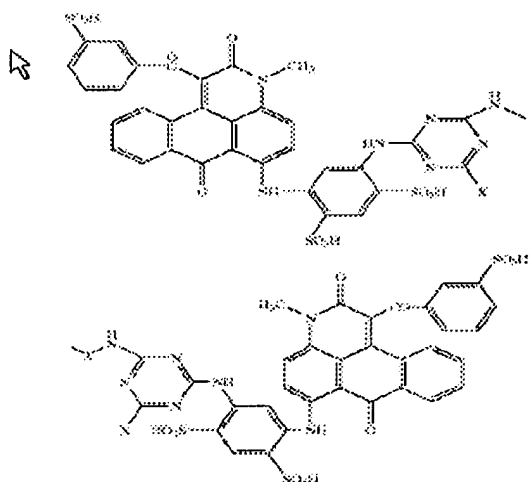
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-2, 10-14 & 16-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 16-20, 22 & 24 of U.S. Patent No. 6,852,154. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is disclosed in the US Patent and is covered by the US Patent, since the US Patent and the application are claiming common subject matter, as follows as shown in Table: 1 & 2 below.

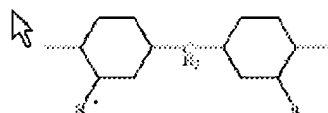
TABLE: 1

10/651,304 CLAIMS

1. An ink composition comprising at least water; at least one member selected from compounds represented by the following formula (1) and/or salts thereof; and at least one member selected from carboxyl group-containing aromatic compounds and/or salts thereof:



wherein A represents an alkylene group, a phenylene group-containing alkylene group or



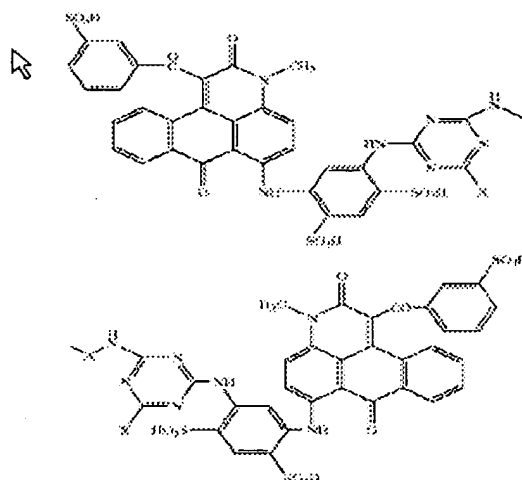
(R means hydrogen or alkyl) and X represents NH₂, OH or Cl.

17. The ink composition according to claim 1, which is magenta ink composition.

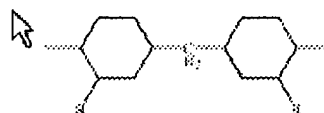
2. The ink composition according to claim 1, wherein the compound represented by formula (1) and/or salt thereof are contained in an amount of 0.2 to 10% by weight based on the total amount of the ink composition.

US 6852154 CLAIMS

1. An ink set comprising a yellow ink composition, a magenta ink composition, and a cyan ink composition, wherein the magenta ink composition contains as a colorant at least one member selected from compounds represented by the following formula (1) and salts thereof:



wherein A represents an alkylene group, an alkylene group having a phenylene group, or a group represented by



wherein R means a hydrogen atom or an alkyl group, and X represents NH₂, OH or Cl.

2. The ink composition according to claim 1, wherein the magenta ink composition contains as a colorant the at least one member selected from compounds represented by formula (1) and salts thereof in a total amount of from 1.0 to 10% by weight based on the overall weight of the magenta ink composition.

TABLE: 2

10. The ink composition according to claim 1 further comprising a nonionic surfactant.	16. The ink set of claim 1 or 3, wherein the ink compositions contain a nonionic surfactant.
11. The ink composition according to claim 10, wherein a nonionic surfactant is an acetylene glycol-based surfactant.	17. The ink set of claim 16, wherein the nonionic surfactant is an acetylene glycol-based surfactant.
12. The ink composition according to claim 10, wherein the nonionic surfactant is contained in an amount of from 0.1 to 5% by weight based on the total weight of the ink composition.	18. The ink set of claim 16, wherein each ink composition contains the nonionic surfactant in an amount of from 0.1 to 5% by weight based on the overall weight of the ink composition.
13. The ink composition according to claim 1, further comprising a penetration accelerator.	19. The ink set of claim 1 or 3, wherein the ink compositions contain a penetration accelerator.
14. The ink composition according to claim 13, wherein the penetration accelerator is a glycol ether.	20. The ink set of claim 19, wherein the penetration accelerator is a glycol ether.
16. The ink composition according to claim 1, which is used in an inkjet recording process.	22. An ink-jet recording process comprising conducting recording with an ink set of claim 1 or 3.
18. An ink jet recording process comprising ejecting a droplet of an ink composition, and depositing the droplet onto a recording medium to perform printing, wherein the ink composition is one according to claim 1.	
19. Recorded matter recorded using an ink composition according to claim 1.	24. Recorded matter obtained by recording with an ink set of claim 1 or 3.

The pending application claiming the ink composition and the US Patent claiming the ink set, and both of them using the same compound in the ink.

However, the US patent didn't claiming the single ink composition but it is obvious to one of ordinary skill in the art that to get the single color printed image use only one color ink.

It was obvious to one of ordinary skill in the art at the time of invention was made to use the ink set taught in the US Patent in to the ink composition of pending application to get the single colored printed image.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

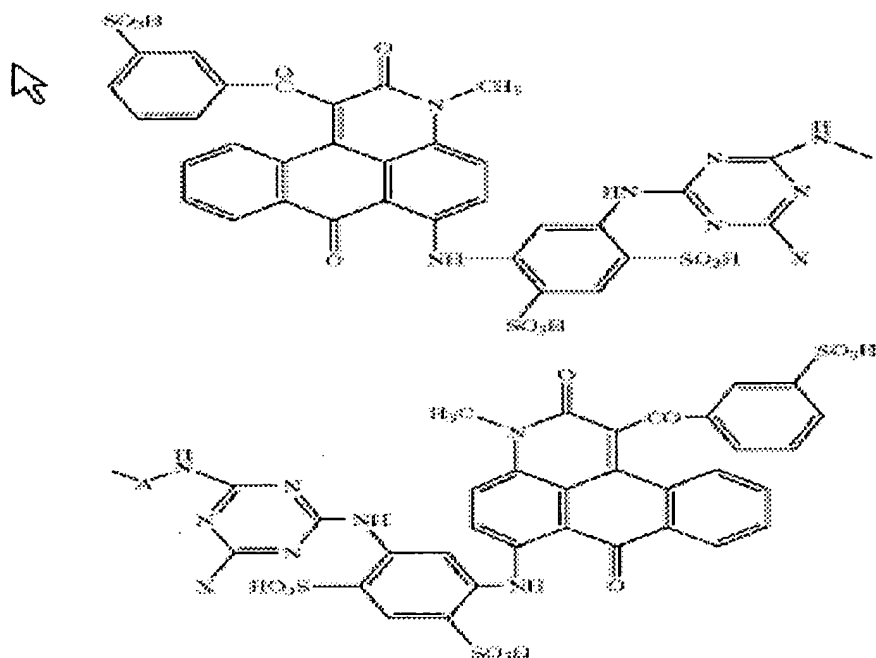
3. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al (# US 2004/0239739).

Matsumoto et al. discloses:

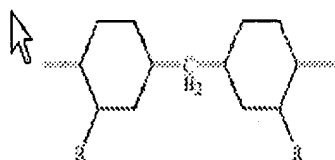
- an ink composition comprising at least water; at least one member selected from compounds represented by the following formula (1) and/or salts thereof; and at

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least one member selected from carboxyl group-containing aromatic compounds and/or salts thereof:



wherein A represents an alkylene group, a phenylene group-containing alkylene group or



(R means hydrogen or alkyl) and X represents NH₂, OH or Cl. ([0016], [0034], [0036]).

- The compound represented by formula (1) and/or salt thereof are contained in an amount of 0.2 to 10% by weight based on the total amount of the ink composition ([0090]).
- The carboxyl group containing aromatic compound and/or salt thereof are contained in an amount of 0.2 to 10% by weight based on the total amount of the ink composition ([0063], [0064]), wherein carboxyl group containing aromatic compound is naphthalene skeleton containing compound and having at the 2-position ([0070]) and lithium salt ([0080]).
- The ink composition includes the nonionic surfactant is an acetylene glycol based surfactant, in an amount of 0.1 to 5% by weight ([0094], [0103]); a glycol ether based penetration accelerator ([0092]). The ink composition has a pH of 8.0 to 10.5 ([0089]).
- The ink composition used in ink jet recording process ([0042]-[0046]).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manish S. Shah whose telephone number is (571) 272-2152. The examiner can normally be reached on 8:00am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen D. Meier can be reached on (571) 272-2149. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manish S. Shah
Primary Examiner
Art Unit 2853


MSS
3/16/05